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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 28, 00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hanford Hotels Inc.

Serial No. 75/181,052

Barbara L. Friedman and David M. Klein of Bryan Cave for
Hanford Hotels Inc.

James Pacious and Susan J. Kastriner, Trademark Examining
Attorneys, Law Office 113 (Meryl Hershkowitz, Managing
Attorney)

Before Simms, Holtzman and Rogers, Administrative Trademark
Judges.

Opinion by Rogers, Administrative Trademark Judge:

Hanford Hotels Inc. has filed an application to
register STERLING CLUB as a service mark for "hotel
services for preferred customers featuring preferential

room rates, upgraded rooms, newspaper delivery, and prizes earned from points accumulated after several stays."¹

The Trademark Examining Attorney made final a refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, if used in connection with the identified services, will create a likelihood of confusion or mistake among consumers, or will deceive consumers, in view of the prior registration of STERLING INN for "motel services."²

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal of registration.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the relatedness of the services, and the classes of

¹ Serial No. 75/181,052, in International Class 42, filed October 15, 1996, based on applicant's allegation of a bona fide intention to use the mark in commerce.

² Registration No. 1,492,725, in International Class 42, issued June 14, 1988; combined affidavit of use and incontestability, under Sections 8 and 15, respectively, of the Trademark Act,

consumers for these services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In the comparing the marks, we note that "INN" is the subject of a disclaimer in the cited registration and that "CLUB" is the subject of a disclaimer in applicant's application. Accordingly, while we do not ignore the disclaimed element in each mark, we focus on the remaining and dominant element in each mark, i.e., "STERLING." See *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) (disclaimed matter typically less significant than other components of trademarks).

Applicant argues that the word "Sterling" is entitled to limited protection because, for both applicant and registrant, it has a highly suggestive connotation indicating that the respective services are of a superior quality. In support of the argument, applicant attempts to rely on the asserted existence of numerous third-party registrations including the term "Sterling." The Examining Attorney, however, quite correctly objected to applicant's attempt to rely on these as ineffectual. First, applicant claims there are "at least 259 active registrations and

filed on June 10, 1994, but still pending before the Post Registration Branch.

applications that include the word 'sterling'; yet in support of the claim applicant has submitted only a chart of its own making which lists just 21 of these. Second, to make even these 21 registrations and applications properly of record, applicant would have had to submit copies of the certificates or applications, or printouts from the Office's X-Search or TESS systems.³ Third, it is well-settled that third-party registrations are not evidence that the marks in those registrations are in use in commerce or that consumers are familiar with the marks. In short, the Examining Attorney's objection to applicant's attempt to rely on third-party registrations and applications is well-taken and we have not considered them.

In regard to the marks, then, we find that they sound alike and likely would create substantially the same commercial impression among consumers. When the marks are so similar, the goods or services of an applicant and registrant need not be as close to support a finding of likelihood of confusion. See authorities collected in 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 1999) ("The greater the similarity in the

³ The X-Search system is the Office's internal search system. The TESS system is accessible by accessing the Office's home page on the World Wide Web, at www.uspto.gov. Printouts from either system are acceptable in lieu of photocopies of registrations and applications.

marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion.").

Turning to the respective services of applicant and registrant, it is clear that hotel or motel services and frequent guest programs are related. We need look no further than applicant's own activities to reach this conclusion. Applicant offers hotel services and a preferred customer program for its frequent guests.

Notwithstanding the relatedness of the services involved in this appeal, applicant argues that its hotel rooms are, on average, much more expensive than registrant's motel rooms and applicant's customers are, therefore, more sophisticated purchasers; that applicant's customers who would be offered membership in its preferred customer club would not be first time or infrequent guests of applicant's hotels; that registrant, on information and belief, does not offer a frequent guest program; and that applicant would always use its house mark for its hotels, i.e., HANFORD, in conjunction with its frequent guest program mark.

We note that the registration for applicant's house mark, HANFORD, covers both hotel and motel services and that distinctions between hotels and motels are not always

clear to consumers. In this regard, we take judicial notice of the following definition for "hotel" from 189 The Travel Dictionary (1998): "Place offering accommodations. Also called inn, motor hotel, motor lodge, motel. Hotels are generally large and may not have extensive parking facilities." Moreover, we note that a hotel company may operate more than one hotel or motel chain, so as to offer guests alternatives in terms of price and accommodations. For example, note that information regarding the COURTYARD, FAIRFIELD INN, MARRIOTT and RESIDENCE INN chains are all available through the website www.marriott.com. See 348-49 The Travel Dictionary (1998). Thus, even purchasers of applicant's hotel or motel services may, when offered membership in applicant's frequent guest club, mistakenly believe that the HANFORD properties and registrant's properties are related or affiliated.

In addition, though applicant asserts that it will use its house mark in conjunction with its frequent guest club mark, it seeks registration for the latter alone, not the composite HANFORD STERLING CLUB. Similarly, while applicant asserts it will offer membership in its frequent

guest club only to frequent users of Hanford properties, its identification of services is not so limited.⁴

Finally, we note that even if registrant is not now offering guests of its properties membership in a frequent guest program or club, it may do so in the future. We agree with the Examining Attorney that we must consider this to be within the zone of registrant's natural expansion. See discussion at 4 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §24:17 (4th ed. 1999) ("a trademark owner should be given rights in its trademark, not only for the goods it actually sells, but for all product markets into which it might reasonably be expected to expand in the future.").⁵

Decision: The refusal of registration under Section 2(d) of the statute is affirmed.

R. L. Simms

⁴ In this regard, we acknowledge that applicant attempted to amend the identification to include reference to its house mark, but that the Examining Attorney rejected this amendment, on the ground that a registered trademark may not be used in an identification of goods. Applicant could have offered alternative limiting language, but did not.

⁵ We note that this case presents circumstances wherein a consent agreement between applicant and registrant might have helped applicant considerably. Without such an agreement, any doubt must be resolved in favor of registrant.

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T. E. Holtzman

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board